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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,738	09/08/2000	Junji Otani	NV/P-22090/A	3187

324 7590 01/31/2005

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/657,738

Applicant(s)

OTANI ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 7 and 13.

Claim(s) withdrawn from consideration: 14-17.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper ~~No(s)~~ rec'd 12 Oct 2004.
10. ☐ Other: _____

Continuation of 2. NOTE:

Proposed amended claim 7 defines Z but deletes the formula that contains Z.

The proposed amendment to currently withdrawn claims 14-17 raises new issues that would require further consideration and search in the event that the examiner were to be persuaded as to the patentability of claim 7 (either as finally rejected or as set forth in the proposed amendment). Proposed claims 14-17 do not read on the elected species but, if claim 7 were to be allowed, may be subject to consideration/examination on the merits due to overlapping subject matter with claim 7 and/or because of claim dependency. Examples of these new issues are as follows:

Proposed claims 15 and 16 encompass compounds within the scope of finally rejected claim 7 and proposed claim 7. Proposed claim 16 also encompasses compounds that are not within the scope of finally rejected or proposed claim 7. Accordingly, if claims 15 and 16 were to be rejoined upon allowance of claim 7 due to overlapping subject matter, claim 16 would require further consideration and search in order to determine the patentability of the compounds that are not within the scope of claim 7.

The proposed amendment to withdrawn claim 17 converts claim 17 from an independent claim to a claim that is dependent from claim 7. However, none of the compounds as defined in proposed claim 17 are within the scope of compounds as defined in finally rejected or proposed claim 7, thus raising a new issue at least under 35 U.S.C. 112, second paragraph.

Proposed claim 14 does not encompass compounds within the scope of finally rejected or proposed claim 7, but does encompass compounds within the scope of proposed claim 17 as well as compounds outside the scope of proposed claim 17.

Continuation of 5. does NOT place the application in condition for allowance because:

The examiner maintains the position of record regarding the obviousness of claims 7 and 13 over Jost et al. (4,585,878). Claim 7 is drawn to a fluorescent compound, and claim 13 is drawn to a compound with no limitation on the properties of the compound. The examiner maintains that compounds within the scope of claims 7 and 13 would have been prima facie obvious to one of ordinary skill in the art at the time of the invention given Jost's teachings. (The Rule 132 Declaration received 18 January 2005 is a copy of the declaration originally filed 07 May 2002 and has previously been considered by the examiner.)



MARIE YAMNITZKY
PRIMARY EXAMINER

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